



AF/1775

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<b>TRANSMITTAL FORM</b> <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/931,347	<b>RECEIVED</b> <b>MAR 11 2004</b> <b>TC 1700</b>
	Filing Date	08/16/2001	
	First Named Inventor	NAGARAJ et al.	
	Art Unit	1775	
	Examiner Name	J. McNeil	
Total Number of Pages in This Submission	7	Attorney Docket Number	13DV-14035/11702 (21635-0044)

ENCLOSURES (check all that apply)		
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Response to Final Rejection

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hafnium of the substrate...The term 'added' is not considered to structurally limit the article over that of the prior art." Applicant must respectfully traverse this argument for two reasons.

First, "added" does structurally limit the article over that of the prior art. "Added" must be interpreted to mean something different from "elements diffused into the protective coating from the substrate". Claim 1 recites in part:

"the outer layer comprises...added hafnium, elements diffused into the protective coating from the substrate..."

By the normal rules of claim construction, the "added hafnium" is not within the scope of "elements diffused into the protective coating from the substrate", and is necessarily an amount of hafnium that is in addition to any hafnium that is diffused into the protective coating from the substrate. The "added hafnium" may not be interpreted to be within the scope of "elements diffused into the protective coating from the substrate", because this would amount to a repetition of the claimed content.

The Examiner's position is that any hafnium in the outer layer of Schaeffer is present as an element diffused into the protective coating from the substrate. That hafnium would be hafnium within the scope of "elements diffused into the protective coating from the substrate", but it would not be within the scope of "added hafnium". "Added hafnium" therefore does structurally distinguish the present claim from Schaeffer's disclosure.

Second, there is no explicit disclosure in Schaeffer that the coating contains hafnium. Keeping in mind that the rejection is under Section 102, the reference to "it is fully expected" in the Response to Arguments is apparently an assertion of inherency--an argument that the outer layer of the coating inherently contains hafnium from the substrate. MPEP 2112-2113 sets forth the law on inherency. Inherency is not to be taken lightly and not to be asserted unless there is good evidence to suggest that the asserted property or

characteristic is necessarily present in the teachings of the prior art reference. The concept of inherency is not provided as a way to fill in the gaps in missing disclosure or teachings based upon speculation, unless the asserted property or characteristic may be shown to be necessarily present by objective evidence. Instead, “inherency” is used when every aspect of the disclosure of a reference and the claimed subject matter are otherwise exactly the same, then it may be inferred that some property or characteristic further recited in the claim must necessarily be present in the art reference. MPEP 2112 provides, “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.’ Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)”.

If the Section 102 rejection is maintained, Applicant asks that the Examiner provide the basis in fact or technical reasoning that an “outer layer” of Schaeffer’s coating necessarily contains hafnium diffused from the substrate. Assuming that showing is made, there is still the first point to be considered--any hafnium reaching the outer layer is within the scope of “elements diffused into the protective coating from the substrate”, but not within the scope of “added hafnium”.

Applicant asks that the Examiner reconsider and withdraw this ground of rejection.

Application No. 09/931,347  
Attorney Docket No. 13DV-14035/11702 (21635-0044)

Claims 6-7 are rejected under 35 U.S.C. § 103 as unpatentable over Schaeffer '405. Applicant traverses this ground of rejection for two reasons.

First, claims 6-7 depend from claim 1. The limitations of claim 1 are not taught by Schaeffer for the reasons stated above. There is no teaching of any amount of "added hafnium", in addition to "elements diffused into the protective coating from the substrate", nor is there any showing of inherency.

Second, Schaeffer has no teaching of "the protective coating has an average platinum composition comprising from about 20 to about 30 weight percent platinum averaged over locations from about 10 micrometers below the protective coating outer surface to about 20 micrometers below the protective coating outer surface", as recited in claim 6, or "the protective coating has an average aluminum composition comprising from about 15 to about 25 weight percent aluminum averaged over locations from about 10 micrometers below the protective coating outer surface to about 20 micrometers below the protective coating outer surface", as recited in claim 7 [emphasis added]. Schaeffer averages over some different spatial limits, see for example col. 5, lines 21-47. There is no teaching of any information gained by averaging "over locations from about 10 micrometers below the protective coating outer surface to about 20 micrometers below the protective coating outer surface", as recited in the claims. If it should be asserted that such would inherently be the case in view of Schaeffer's teachings, the inherency issue is raised again and must be addressed again.

Applicant asks that the Examiner reconsider and withdraw this ground of rejection.

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Applicant submits that the application is in condition for allowance, and requests such allowance. The Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 50-1059.

Respectfully submitted,  
MCNEES WALLACE & NURICK LLC



Dated: March 3, 2004

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